



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------------|------------------|
| 10/663,065 | 09/16/2003 | Nicolas D.L. Jones | Wdhd 245 | 2047 |
| James J. Hill Ste. 3000 300 South Wacker Drive Chicago, IL 60606 | | | EXAMINER SORRELL, ERON J | |
| | | | ART UNIT 2182 | PAPER NUMBER |

DATE MAILED: 11/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------------------|--|
| Office Action Summary | Application No. 10/663,065 | Applicant(s) JONES ET AL. | |
| | Examiner Eron J Sorrell | Art Unit 2182 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1-4 are rejected under 35 U.S.C. 102(a) as being anticipated by Reister (WO 02/052791 A2).

3. Referring to claim 1, Reister teaches an active connectivity module representing a node in an industrial control network comprising:

a housing (see items labeled 7 in figure 1 and paragraphs 13 and 14 on pages 5 and 6);

first and second bus data connectors mounted to said housing and providing connectivity to a data bus of said network (see items labeled 8 in figure 1 and paragraphs 13 and 14 on pages 5 and 6);

a plurality of device data connectors mounted to said housing and each associated with an input device or an output

Art Unit: 2182

device (see items labeled 3,4,5, and 6 in figure 1 and paragraphs 13 and 14 of pages 5 and 6);

a central processor unit connected to said network and to said data bus and input devices or output devices by means of said device data connectors (although not explicitly taught by Reister it is inherent that the terminal devices (network switches and PCs) disclosed by Reister have CPUs that are connected to the network, the data bus and the I/O devices); and

a memory unit coupled to said central processor unit and removably mounted on said housing, said memory unit in signal communication with said central processor unit, said memory unit storing at least address data representing the address of a network node with which said module is associated, and network configuration data including data sheet parameters associated with said node (see items 11 and 12 of figure 1 and paragraphs 8,9, and 14 of pages 3-6; note Reister teaches all of the configuration data can be stored in the memory including configurations stored originally at the factory or manufacturer (data sheet parameters) and configurations required which are necessary for complex networks and communications).

4. Referring to claim 2, Reister teaches the device data connectors comprise a plurality of data connectors associated

Art Unit: 2182

respectively with corresponding input devices (see items 3 and 5 in figure 1 and paragraphs 12 bridging pages 4 and 5).

5. Referring to claim 3, Reister teaches the device data connectors comprise a plurality of data connectors each associated with an output device (see paragraphs 13 and 14 of pages 5 and 6).

6. Referring to claim 4, Reister teaches the device data connectors include a plurality of data connectors each associated with an input device whereby said module is capable of communicating with both input devices and output devices (see items 5 and 6 of figure 1 and paragraphs 12-14 of pages 5 and 6).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2182

8. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reister.

9. Referring to claims 5-7, Reister fails to explicitly set forth the limitations the address data includes data representative of the node address, the MAC identification, and an IP address associated with the address of said node, and wherein the data stored in said removable memory unit comprises the network configuration parameters including data sheet parameters, GDS parameters, network system parameters, TCP/IP configuration and DHCP server information, and further wherein said data stored in said removable memory unit includes storage and maintenance data, including an error log and initial startup parameters and date and time data. However, Reister does disclose that the removable memory unit stores, not only the configurations stored originally at the factory or by the manufacturer, but also the altered configurations which are necessary in complex networks. Reister further teaches that the entire configuration such as the operating and communications parameters of the device or component is stored in the removable memory.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the

Art Unit: 2182

apparatus of Reister to include all of the limitations mentioned above. One of ordinary skill in the art would have been motivated to make such modification because Reister suggests all operating and communication configuration parameters should be stored and the above limitations are either an operating parameter or a communications parameter.

Response to Arguments

10. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following reference is cited to show the state of the art as it pertains to network connectivity modules:

US 2004/0117463 A1 to Reister is cited as it is an English translation of Reister (WO 02/052791 A2);

US 2004/0010627 A1 to Ellis et al. is cited as it shows a network switch comprising a CPU in support of the inherency claim made in the rejection of claim 1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eron J


Art Unit: 2182

Sorrell whose telephone number is 571 272-4160. The examiner can normally be reached on Monday-Friday 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on 571 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EJS
November 16, 2004



JEFFREY GAFFIN
SENIOR PATENT EXAMINER
TECHNICAL CENTER 2100